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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,707	10/20/2003	Mitsuyoshi Tachimori	05225.0161-01	2843
22852	7590	08/10/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			LERNER, MARTIN	
			ART UNIT	PAPER NUMBER
			2654	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,707

Applicant(s)

TACHIMORI ET AL.

Examiner

Martin Lerner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 3, 19, and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 3, 19, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 3, 19, and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 17 of U.S. Patent No. 6,718,304. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth the same subject matter with different words.

Specifically, current independent claim 1 and corresponding independent claim 1 of the patent set forth obtaining recognition results of a user's input speech, calculating, if the recognition result represents a point on a map, a distance between the point and a base point, deciding whether the distance is above a threshold, and outputting, if the

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distance is above a threshold, an inquiry to confirm whether the recognition result is correct.

Current claim 2, corresponding to claim 5 of the patent, sets forth that if the distance is not above a threshold, outputting a recognition result without inquiry.

Current claim 3, corresponding to claim 2 of the patent, sets forth that if the recognition result does not represent a point on the map, a recognition result is output without inquiry.

Current independent claim 19 and corresponding independent claim 16 of the patent set forth a speech recognition unit configured to recognize a user's input speech, a distance decision unit configured to calculate a distance between a point of the recognition result and a base point on a map if the recognition result represents a point on the map, deciding whether the distance is above a threshold, and a response generation unit configured to generate an inquiry to confirm whether the recognition result is correct if the distance is above a threshold.

Current independent claim 21 and corresponding independent claim 17 of the patent set forth instructions for causing a computer to recognize a user's input speech, instructions for causing a computer to calculate, if the recognition result represents a point on a map, a distance between the point and a base point on the map, instructions for causing a computer to decide whether the distance is above a threshold, and instructions for causing a computer to output, if the distance is above a threshold, an inquiry to confirm whether the recognition result is correct.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The limitation of “previously determining to output the recognition result with the inquiry or without the inquiry” if the recognition result does not represent a point on the map is new matter. The Specification was reviewed, but does not clearly provide a written description for an embodiment of previously determining. Mainly, the Specification discloses a procedure to be followed if the recognition result is determined to be a point on a map. Applicants have not cited any passages from the Specification providing a written description of a procedure when recognition results do not represent a point on the map.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 3, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Liu et al.* in view of *Brems et al.*

Regarding independent claims 1, 19, and 21, *Liu et al.* discloses a speech recognition method, apparatus, and computer readable instructions, comprising:

“a speech recognition unit configured to assign a recognition result to the user's input speech” – a mobile navigation system includes an input device, which can be a speech recognition device (column 5, lines 64 to 66: Figure 7); a speech recognition device produces a recognition result for a user's speech;

“a distance decision unit configured to calculate a distance between a point of the recognition result and a base point on the map if the recognition result represents a point on the map, and to decide whether the distance is above a threshold” – search manager 706 parses the request and obtains information pertaining to the request search; search manager 706 then obtains the position of the reference point for the current position (“a base point”); search manager then proceeds to look up the digital map and construct an initial list of points of interest (“a point of the recognition result”) based on the distance constraint (“a threshold”), for example, within, say twenty miles from the current position (column 6, line 62 to column 7, line 17: Figure 9: Steps 902 to 908); the search manager follows to prune this list by the itinerary constraint; for example, the user wants no more than five miles of deviation from the routes defined in his current itinerary (column 7, lines 5 to 17: Figure 9: Steps 908 and 910); five miles

from the current itinerary or twenty miles from the current position is “a threshold” for the distance.

Regarding independent claims 1, 19, and 21, *Liu et al.* discloses then sending the list of choices to the user interface manager, but omits “a response generation unit configured to generate an inquiry to confirm whether the recognition result is correct if the distance is above the threshold.” However, it is quite common in speech recognition systems to ask the user to confirm a recognition result if there is a low degree of confidence in the result. In *Liu et al.*, a recognition result is uncertain if a distance of the recognition result from the current location is above a threshold. *Brems et al.* teaches a speech recognition system where a confidence in the interpretation is determined, and for an intermediate level of uncertainty, the user is asked to explicitly verify (or dis-verify) the result. (Column 6, Lines 11 to 44; Figure 5: Steps 411 and 413) *Brems et al.* suggests this procedure has advantages over forcing the user to re-enter information, and by mapping the confidence or “certainty level” of the results into several different action alternatives the consequences of making an error and the difficulty for the user responding to a verification request is considerably improved. (Column 2, Lines 23 to 32; Column 6, Lines 27 to 28) It would have been obvious to one of ordinary skill in the art to require a user to confirm whether a recognition result is correct if the distance is above a threshold in *Liu et al.* as suggested by *Brems et al.* for the purpose of improving the verification procedure

Regarding claim 2, *Brems et al.* teaches the recognition interpretation is accepted without explicit verification if the interpretation has a high likelihood of being

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correct (column 6, lines 11 to 24: Figure 5: Steps 405 and 407); in *Liu et al.*, a high likelihood of being correct corresponds to “a distance not above the threshold.”

Regarding claim 3, *Liu et al.* discloses requests besides search requests, e.g. a maneuver command (“does not represent a point on the map”)(column 6, lines 30 to 61: Figure 8: Step 862); a maneuver command follows a procedure which does not inquire based upon whether a distance is above a threshold.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

LaRue and Ishii et al. disclose related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (703) 308-9064. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

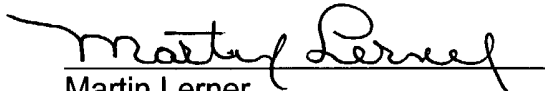
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (703) 305-9645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML  
8/3/04

  
Martin Lerner  
Examiner  
Group Art Unit 2654